

REMARKS

I. Introduction

Claims 17 to 31 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As an initial matter, it is Applicants' understanding that the period for responding to the Final Office Action dated October 1, 2003 was restarted with the mailing of the present Final Office Action on December 1, 2003.

II. Rejection of Claims 17 to 31 Under 35 U.S.C. § 103(a)

Claims 17 to 31 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,493,481 ("Merkle '481") and U.S. Patent No. 4,518,154 ("Merkle '154"). Applicants respectfully submit that the combination of Merkle '481 and Merkle '154 does not render unpatentable the present claims as amended herein for the following reasons.

a. Claims 17 to 23

Claim 17 relates to a combined spring-and-shock-absorber system. Claim 17 recites that the system includes, inter alia, a hydraulic accumulator and a tubular roll bellows. Claim 17 as originally filed recited that the bellows includes a bellows interior that is filled with a fluid and that is configured to communicate with the hydraulic accumulator. The Final Office Action states that the arguments presented in the Amendment filed on June 17, 2003 are not persuasive on the basis that "[t]he accumulator of Merkle '481 is configured to communicate mechanical vibrations from the air spring." Final Office Action at p. 2. As an initial matter, it is respectfully submitted that the phrase "a bellows interior . . . configured to communicate with the hydraulic accumulator" would be understood to mean that the bellows interior is in fluid communication with the hydraulic accumulator rather than a vibrational communication between the bellows interior and the hydraulic accumulator. Notwithstanding the foregoing, claim 17 has been amended herein without prejudice to clarify that "the bellows interior is configured to communicate the fluid with the hydraulic accumulator." It is respectfully submitted that this

amendment raises no new issues since at least claim 21 mentions “a fluid flow between the bellows interior and the hydraulic accumulator.”

Merkle ‘481 purports to relate to a pneumatic spring for motor vehicles, and Merkle ‘154 purports to relate to a pneumatic spring. In addition to all of the arguments more fully set forth in the Amendment filed on June 17, 2003, which are expressly incorporated herein in their entirety by reference thereto, it is respectfully submitted that neither Merkle ‘481 nor Merkle ‘154 discloses, or even suggests, “ [a] bellows interior configured to communicate [a] fluid with [a] hydraulic accumulator” as recited in amended claim 17.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Since the combination of Merkle ‘481 and Merkle ‘154 fails to disclose, or even suggest, all of the limitations of amended claim 17 for the reasons more fully set forth above and more fully set forth in the Amendment filed on June 17, 2003, it is respectfully submitted that the combination of Merkle ‘481 and Merkle ‘154 does not render unpatentable amended claim 17.

As for claims 18 to 23, which ultimately depend from claim 17 and therefore include all of the limitations of claim 17, it is respectfully submitted that the combination of Merkle ‘154 and Merkle ‘481 does not render unpatentable these dependent claims for at least the same reasons given above in support of the patentability of claim 17. In re Fine, supra (any dependent claim depending from a non-obvious independent claim is non-obvious).

b. Claims 24 to 31

Claim 24 relates to a combined spring-and-shock-absorber system and recites that the system includes, inter alia, an accumulator having a volume and a tubular roll bellows, the bellows enclosing a bellows interior filled with a volume of

gas. Claim 24 as originally filed also recited that the bellows interior is controllably connected to the accumulator volume and to a pressure pump via tubular connectors located in a wall of an outer bell. Whether “[t]he accumulator of Merkle ‘481 is configured to communicate mechanical vibrations from the air spring” is entirely irrelevant to the issue of whether the combination of Merkle ‘481 and Merkle ‘154 discloses or suggests a bellows interior controllably connected to an accumulator volume and to a pressure pump via tubular connectors located in a wall of an outer bell as recited in claim 24. Claim 24 has been amended herein without prejudice to recite that the bellows interior is controllably connected to the accumulator volume and to a pressure pump to communicate the gas therebetween via tubular connectors located in the wall of the outer bell. Thus, even if Merkle ‘481 describes an accumulator configured to communicate mechanical vibrations from an air spring -- which Applicants do not concede -- neither Merkle ‘481 nor Merkle ‘154 discloses, or even suggests, a bellows interior controllably connected to an accumulator volume and to a pressure pump to communicate a gas therebetween via tubular connectors located in a wall of an outer bell as recited in amended claim 24. For all of the reasons set forth above and in accordance with the arguments set forth in the Amendment filed on June 17, 2003, which arguments are expressly incorporated herein in their entirety by reference thereto, it is respectfully submitted that the combination of Merkle ‘481 and Merkle ‘154 does not render unpatentable amended claim 24.

As for claims 25 to 31, which ultimately depend from claim 24 and therefore include all of the limitations of claim 24, Applicants respectfully submit that the combination of Merkle ‘481 and Merkle ‘154 does not render unpatentable these dependent claims for at least the same reasons set forth above in support of the patentability of claim 24. Id.

In summary, Applicants respectfully submit that the combination of Merkle ‘481 and Merkle ‘154 does not render unpatentable any of claims 17 to 31. Withdrawal of this rejection is therefore respectfully requested.

III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: December 30, 2003 By: Richard L. Mayer
Reg. No. 22,490 *13, No. 42, 198*

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646